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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/500,668

06/30/2004

Michel Valentin

36880

6555

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7590

07/28/2006

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CLEVELAND, OH 44114-3108

EXAMINER

STERLING, AMY JO

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/500,668

Applicant(s)

VALENTIN ET AL.

Examiner

Amy J. Sterling

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-17 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-17, 21-23, 25 and 26 is/are rejected.
- 7) ☒ Claim(s) 19, 20, 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is the **Final Office Action** for application number 10/500,668 Support for Moving Cylindrical Elements and Method and Conveyor Using Such Supports, filed on 6/30/04. Claims 14-17 and 19-26 are pending. This **Final Office Action** is in response to applicant's reply dated 6/7/06. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show "the slot formed in the body 34" (page 15, line 2) as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement

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sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 19 and 20 are objected to because of the following informalities:

Claims 19 and 20 depend from claim 18 which has been cancelled. The claims were not considered due to this issue. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-16, 21, 22, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 4470291 to Gibb et al.

The patent to Gibb et al. discloses a rolling cylindrical support having a first guide means (62, 12) capable of guiding a cylindrical element at a height z1, and in the

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downstream direction in which the cylindrical elements roll, a second guide means (28) capable of authorizing a rotation around an axis of and for guiding the cylindrical elements at a height  $z_2$ , higher than  $z_1$ , the friction between the second guide means and the cylindrical element (30) being lower than the friction between the first guide means and the cylindrical elements. Gibb et al. also teaches wherein the second guide means has at least two ball bearings (90) and have a lateral adjustment system (24, 12) that moves the cylindrical element and the lateral adjustment is formed by the first and second guide means and a vertical adjustment system (26, 12) formed by the first and second guide means which is the means by which the height different between  $z_1$  and  $z_2$  may be adjusted. Gibb et al. also teaches the method steps of primary guiding with the aid of the first guide means, secondary guiding substituting the primary guiding with the aid of the second guide means, the friction resulting from the secondary guiding being lower than the friction resulting from the primary guiding.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 4470291 to Gibb et al. as applied to claims 14 and 16 above, and in view of United States Patent No. 5843369 to Obara et al.

Gibb et al. does not specifically teach that the ball bearings are made of stainless steel material.

Obara et al. teaches a ball bearing made from stainless steel (See Col. 3, line 9 for material), used for its strength and other desired properties. Therefore it would have been obvious to one of ordinary skill in the art from the teachings of Obara et al. to have made the device of stainless steel in order to have a strong and rust resistant device.

Claims 23, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 4470291 to Gibb et al. as applied to claims 14 above.

It would have been obvious to one of ordinary skill in the art to have made the height difference of any dimension, in order to support the device in the manner desired, the dimension being a design choice which would be obvious to optimize. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made from the teachings of Gibb et al. to have optimized the dimensions of the device including 0.5mm difference.

### ***Response to Arguments***

The applicant has argued that the rejection under 35 USC 112, first paragraph should be withdrawn because the details of the connection of roller (4) is specifically taught on page 14 of the specification. This is persuasive and the rejection has been withdrawn. However, new drawing objection (see above) has been added in that the

drawings do not clearly show all the details necessary in line with the written description. The “slots” must be shown in order to convey the adjustability of the device.

The applicant has also argued that the Gibb et al. reference does not disclose a second height being higher than the first. This is unpersuasive in that the applicant is arguing the claims narrower than recited and that the Gibb et al. reference meets the claim as recited. Claim 14 recites a “second guide means capable of guiding the cylindrical element at a height  $z_2$  higher than  $z_1$ ”. Due to the functionality of the limitation, the second guide means only has to be “capable” of performing such a function”. Since the “second guide means 28”, as defined by the rejection above, is height adjustable, it is clearly “capable” of being adjusted to a higher height  $z_2$ . Further, the motivation for adjusting the height is not relevant as long as the device meets the structural limitations.

The applicant has also argued that the second guide means is not “downstream” in the direction in which the cylindrical elements roll” and that it does not disclose that the friction between the second guide means is lower. This is unpersuasive in that without further defining what is meant by “downstream” to a limitation that has only been claimed in a functional manner, the second guide means is “downstream”. In addition, since the cylindrical element can operatively move in either lateral direction, the second guide means would be considered “downstream”. Also, it is inherent that the friction is less in the guide means that contains the ball bearings relative to the one that does not.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Gibb and the Obara reference both contain ball bearings. Choosing a suitable material for the ball bearings is a well known and recognized motivation.

#### ***Allowable Subject Matter***

Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The reason is that the prior art does not show wherein the first guide means is a Vee shaped roller.

#### ***Conclusion***


**THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. Any inquiry concerning this communication should be directed to Amy J. Sterling at telephone number 571-272-6823. The fax machine number for the Technology center is 571-273-8300 (formal amendments) or 571-273-6823 (informal communications only). Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist at 571-272-3600.

  
Amy J. Sterling  
Primary Examiner  
7/18/06